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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,397

06/23/2006

Peter Richard Van Smirren

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT

PAPER NUMBER

3782

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,397	<b>Applicant(s)</b> VAN SMIRREN, PETER RICHARD	
	<b>Examiner</b> Justin M. Larson	<b>Art Unit</b> 3782	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-16 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/4/10</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 11/4/10 is noted. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5-11, 13-16, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobsen et al. (US 4,792,180 A).

Regarding claims 1, 3, 5-7, and 14-16, Jacobsen disclose a method of attaching a load carrier fixing member (42 which can be considered a roof rail or trim finisher) to a vehicle, the method comprising applying adhesive (56) to the vehicle roof (12), and attaching the fixing member to the vehicle (Figure 2), for subsequent attachment of a load carrier (such limitation being completely functional where a load carrier such as a roof rack could be attached to the trim finisher 42 of Jacobsen if a user so desired, this idea supported by Applicant's own claim 8), the fixing member comprising a surface with at least one undercut (58).

Regarding claims 8 and 9, a fixing member trim finisher (68) is removably attached to a non-adhered side of the fixing member (see Figure 3).

Art Unit: 3782

Regarding claims 10 and 11, the fixing member comprises at least one gap hider (50,52) that is positioned between the fixing member and the vehicle.

Regarding claim 13, the fixing member is secured in position using one or more locating members (50,52) which are shaped to hold the fixing member in place (maintains side-to-side position within gap).

Regarding claim 23, a portion (66) of the fixing member is adapted to be hooked under a pair of the vehicle roof (see Figure 3).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. in view of Beecher et al. (US 4,904,328 A).

Jacobsen discloses the method as claimed except for the step of cleaning the part (roof) of the vehicle to be worked on. Beecher, however, teaches that it was already known in the art to clean a bonding surface by sanding and/or wiping in order to increase the adhesive potential of the bond (see abstract and col. 1 lines 19-21). While Beecher focuses on FRP vehicle parts, one of ordinary skill in the art, after studying Beecher, through their own available knowledge and reasoning, would realize that such surface cleaning could be useful in just about any situation where bonding was needed, not limited to FRP parts. Thus it would have been obvious to one having ordinary skill in

Art Unit: 3782

the art at the time the invention was made to have cleaned the roof of Jacobsen before applying the adhesive, the motivation being to increase the adhesive potential in the manner taught by Beecher.

### ***Response to Arguments***

6. Applicant's arguments filed 11/4/10 have been fully considered but they are not persuasive. Applicant has asserted that element (42) of Jacobsen is not a "load carrier" to the extent claimed and that element (42) is simply a gap filler that is not capable of supporting a load. Examiner notes that the claims as currently presented set forth no structure that serves to preclude the element (42) of Jacobsen from being considered a "load carrier fixing member" as claimed. Element (42) of Jacobsen includes all of the presently claimed load carrier fixing member structure and can thus be considered a load carrier fixing member to the extent claimed. Even if Jacobsen does not mention a load carrier being affixed to element (42), nothing in Jacobsen would prevent a user from affixing a load carrier to element (42). Applicant's own load carrier fixing element is claimed as a structure adhered within the gap of a vehicle roof. Because element (42) of Jacobsen is a structure adhered within the gap of a vehicle roof, it is also just as capable as Applicant's own invention as having a load carrier affixed thereto. Because element (42) of Jacobsen can be considered a load carrier fixing element as claimed and is shown and described as being attached to a vehicle roof, it follows that Jacobsen does disclose a method of attaching a load carrier fixing member to a vehicle as claimed.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571)272-8649. The examiner can normally be reached on Monday-Friday, 9a-5p (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Larson/  
Primary Examiner, Art Unit 3782  
1/13/11